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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,443	05/11/2001	Dale E. Gulick	2000.039600/TT3769	6306
23720	7590	03/21/2005	EXAMINER	
WILLIAMS, MORGAN & AMERSON, P.C. 10333 RICHMOND, SUITE 1100 HOUSTON, TX 77042			LANIER, BENJAMIN E	
			ART UNIT	PAPER NUMBER
			2132	

DATE MAILED: 03/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/853,443

Applicant(s)

GULICK ET AL.

Examiner

Benjamin E Lanier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed 3 March 2005 amends claims 4, 17. Applicant's amendment has been fully considered and is entered.

Response to Arguments

2. Applicant's arguments filed 3 March 2005 have been fully considered but they are not persuasive. Applicant's arguments that Gennaro does not disclose authenticating biometric data using a random number is not persuasive because the biometric data is encrypted with random data and stored with the random data in a biometric database (Col. 2, lines 1-5, 27-31, 45-57). A user wishing to be authenticated submits a biometric sample that is authenticated against the stored biometric sample. In order to compare the two samples, the random key is used to decrypt the biometric sample that is stored in the database (Col. 2, lines 27-51).

3. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., nonces that are used a single time) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

4. Applicant's arguments, filed 3 March 2005, with respect to the claim objections and 112 rejections have been fully considered and are persuasive. The rejections have been withdrawn.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2, 4, 7-12, 14-17, 20-24, 26, 28-32, 35, 36, 38-47, 50-62, 65, 66, 68-71, 73, 75-80 are rejected under 35 U.S.C. 102(e) as being anticipated by Gennaro, U.S. Patent No. 6,317,834. Referring to claims 1, 2, 4, 8-12, 14, 15, 21-24, 26, 28-32, 36, 39-45, 47, 51-60, 62, 66, 68-71, 73, 75-80, Gennaro discloses a biometric authentication system wherein biometric information in the form of fingerprints, voice pattern, retinal pattern, iris scans, and signatures (Col. 1, lines 35-39) is captured along with personal information unique to each individual (Col. 1, lines 62-67 & Col. 2, lines 32-34), which meets the limitation of receiving biometric data. The biometric data is then encrypted with random data (Col. 2, lines 1-5, 27-31), which meets the limitation of receiving a nonce, and encrypting the biometric data using the nonce and to transmit only encrypted biometric data and the nonce. The encrypted biometric information is then stored along with the random data in a biometric database (Col. 2, lines 45-57). The biometric information can also be encrypted using a key generated from password information (Col. 1, line 67 – Col. 2, line 2), which meets the limitation of receiving a secret, and encrypting the biometric data using only the secret. The system is also capable of decrypting the biometric data (Col. 3, lines 4-19), which meets the limitation of the master device decrypting the encrypted biometric data.

Referring to claims 7, 20, Gennaro discloses acquiring a personal identifier (Col. 2, line 9), which would meet the limitation of the secret comprising a GUID.

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Referring to claims 16, 17, 35, 38, 46, 50, 61, 65, Gennaro discloses that in order to authenticate a biometric record the user provides the system with a personal identifier, which meets the limitation of a GUID or secret, and a biometric sample that corresponds to the biometric record that is being authenticated (Col. 4, lines 41-56).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 25, 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gennaro, U.S. Patent No. 6,317,834, in view of Huang, U.S. Patent No. 5,856,789. Referring to claims 25, 72, Gennaro discloses a biometric authentication system wherein biometric information in the form of fingerprints, voice pattern, retinal pattern, iris scans, and signatures (Col. 1, lines 35-39) is captured along with personal information unique to each individual (Col. 1, lines 62-67 & Col. 2, lines 32-34), which meets the limitation of receiving biometric data. The biometric data is then encrypted with random data (Col. 2, lines 1-5, 27-31), which meets the limitation of receiving a

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nonce, and encrypting the biometric data using the nonce and to transmit only encrypted biometric data and the nonce. The encrypted biometric information is then stored along with the random data in a biometric database (Col. 2, lines 45-57). The biometric information can also be encrypted using a key generated from password information (Col. 1, line 67 – Col. 2, line 2), which meets the limitation of receiving a secret, and encrypting the biometric data using only the secret. Gennaro does not disclose that the system utilizes a processor, north bridge, and south bridge. Huang discloses a computer system containing a processor, north bridge, and south bridge (Col. 2, lines 63-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a computer system configuration of Huang in the biometric authentication system of Gennaro because Huang discloses that disclosed computer system configuration is state of the art (Col. 2, line 63).

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E Lanier whose telephone number is 571-272-3805.

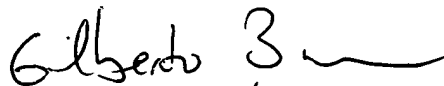
The examiner can normally be reached on M-Th 7:30am-5:00pm, F 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Benjamin E. Lanier



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